



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,142	05/17/2005	Go Mizutani	441P094	5678
42754	7590	02/02/2006	EXAMINER	
NIELDS & LEMACK 176 EAST MAIN STREET, SUITE 7 WESTBORO, MA 01581			BERNSHTEYN, MICHAEL	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/535,142	<b>Applicant(s)</b> MIZUTANI ET AL.	
	<b>Examiner</b> Michael Bernshteyn	<b>Art Unit</b> 1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/28/05, 11/14/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5, 6 and 7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 5, 6 and 7 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ishii et al. (JP 08-194968).

Ishii discloses the protective coating agent for an optical disc which is produced by coating the memory part of the optical disc with a radiation curing resin composition. The composition of the protective coating agent for the optical disc contains more than one (meth) acrylate, i.e., monofunctional monomer or oligomer, in a molecule.  
(abstract).

The curing resin composition contains the following components:

Art Unit: 1713

- the **epoxy (meth)acrylate**, for example bisphenol A epoxy (meth)acrylate. The amount of the epoxy (meth)acrylate is desirable 5-70% by weight (page 3, [0016]);
- mono and polyfunctional acrylate monomers, such as tricyclodecane (meth)acrylate, dicyclopentadieneneoxyethyl (meth) acrylate, dicyclopentanyl (meth) acrylate, **dicyclopentanyl di (meth) acrylate**, **hydroxypivalic acid neopentyl glycol di (meth) acrylate**, etc.; monofunctional (meth) acrylate containing a hydroxyl group, such as **2-hydroxyethyl (meth) acrylate** , etc. The amount of mono and polyfunctional acrylate monomers is desirable 5-90% by weight and especially desirable 10-70% by weight. Two ore more (meth) acrylates can be mixed together depending on the class of radiation used (page 2, [0012]-[0014]);
- a photopolymerization initiators, such as **2,2-dimethoxy-1,2-diphenylethan-1-one**, 1-hydroxycyclohexyl phenyl ketone, 2-hydroxy-2methyl-1-phenylpropane-1-one, etc. The photopolymerization initiator may be used alone or in a mixture of two or more. The amount of the initiators is desirable 0.5-20% by weight (page 3, [0019]-[0020]).

Ishii clearly discloses the resin compositions in the examples 1-3 which do not contain urethane (meth) acrylate (page 4, [0025]-0027], table 1).

Therefore, all the limitations of the instant claims 1-4 are expressly met by Ishii.

***Conclusion***

Other references are considered pertinent to the Applicant disclosure but not cited in this office include U.S. Patents 4,525,258, 5,484,864, 5,568,466, 6,181,859, 6,277,929, 6,667,952, U.S. Patent Application Publications 2004/0010049, 2006/0008222, JP 2002-092961, 2002-114949, 2002-256228 and 2001-049198 are shown on the Notice of References Cited Form (PTO-892).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn  
Patent Examiner  
Art Unit 1713

MB  
02/01/2006

  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700